

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 32

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte MARK T. HOBSON

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Appeal No. 95-3566  
Application No. 07/950,802<sup>1</sup>

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HEARD: March 9, 1999

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Before WINTERS, KIMLIN and GARRIS, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-11, 16, 18 and 20. Claims 12-15 and 21-23 have been allowed by the examiner, and claim 24, the other claim remaining in

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<sup>1</sup> Application for patent filed September 24, 1992.

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the present application, stands withdrawn from consideration  
as being non-elected. Claim 1 is illustrative:

1. A transportable oil skimmer comprising:

a) a frame including a motor support section near one  
end of the frame, the one end being the top end of the frame  
when the skimmer is in use, the frame including a depending  
stabilizer adapted to extend into a volume of liquid when the  
skimmer is in use;

b) a motor carried by the support section and  
including an output shaft;

c) a head pulley drivingly connected to the shaft;

d) an endless belt in drivingly supported engagement  
with the head pulley;

e) a tail pulley supported by the belt and adapted to  
be immersed in such liquid volume when the skimmer is in use;  
and

f) restraining means operatively interposed between  
the stabilizer and the tail pulley to limit axial and radial  
movement when the skimmer is being transported and to allow  
when in use floating movement over a range of movement free of  
engagement between the tail pulley and the restraining means  
while allowing self alignment of the belt and tail pulley and  
sufficient vertical motion when the skimmer is in use to  
assure that belt tension is provided substantially only by the  
weight of the belt and the pulley.

In the rejection of the appealed claims, the examiner  
relies upon the following references:

Mecham	3,055,229	Sep. 25, 1962
Spurr et al. (Spurr)	4,067,438	Jan. 10, 1978
Combrowski	5,223,128	Jun. 29, 1993
		(filed Nov. 20, 1991)

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Abanaki Corporation Literature, "Oil Skimmers" (1989)

Appellant's claimed invention is directed to an apparatus and process for skimming oil from the surface of a body of water. The apparatus is transportable and comprises a tail pulley that is immersed in the body of water which transports an endless belt that removes oil from the surface of the water. According to appellant,

[F]or the first time in such a transportable unit, tension of the belt when in proper use is provided solely by the weight of the tail pulley and the belt itself. This weight tensioning is accomplished by mounted [sic, mounting] the pulley such that it has an ability to float freely relative to the skimmer's stabilizer bar within a range of movement (paragraph bridging pages 2 and 3 of Brief).

Appealed claims 1-7, 16, 18 and 20 stand rejected under 35 U.S.C. § 112, second paragraph. Claims 1-7 and 18 stand rejected under 35 U.S.C. § 112, first paragraph. Claims 1-3, 5 and 6 stand rejected under 35 U.S.C. § 102(b) or, in the alternative, under 35 U.S.C. § 103 as being unpatentable over Abanaki. The appealed claims also stand rejected under 35 U.S.C. § 103 as follows:

- (1) claim 4 over Abanaki;
- (2) claim 16 over Combrowski;
- (3) claims 8-11 over Abanaki in view of Spurr;

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- (4) claims 7 and 18 over Abanaki in view of Mecham; and
- (5) claim 7 over Abanaki in view of Combrowski.

We consider first the rejection of claims 1-7, 16, 18 and 20 under 35 U.S.C. § 112, second paragraph. It is the examiner's position that the language "a range of movement" found in claim 1 is indefinite "as to what degree or amount of movement is implied" (page 3 of Answer). However, since it is axiomatic that claim language must be read in light of the specification as it would be by one of ordinary skill in the art,<sup>2</sup> we agree with appellant that the claims need not specifically recite a particular degree or amount of movement of the tail pulley in order to inform the skilled artisan that the hole in the tail pulley is sufficiently large to allow the bolt (restraining means) inserted therein to be out of contact with the tail pulley. This relationship between the tail pulley and the restraining means is the focal point of the disclosed invention. Accordingly, we will not sustain the examiner's rejection under 35 U.S.C. § 112, second paragraph.

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<sup>2</sup> In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983).

We will also not sustain the examiner's rejection of claims 1-7 and 18 under 35 U.S.C. § 112, first paragraph, as being based upon an original specification that does not provide descriptive support for the language "free of engagement between the tail pulley and restraining means" present in claim 1. According to the examiner, appellant's specification, at page 2, line 32 to page 3, line 1, states that "the headed shaft nonetheless provides a constraint on the range of tail pulley motion relative to the stabilizer bar," and therefore directly contradicts the limitation of "free of engagement between the tail pulley and restraining means" (page 4 of Answer).

The description requirement of 35 U.S.C. § 112, first paragraph, does not require that the later added claim limitation be described in ipsis verbis in the original disclosure<sup>3</sup> but, rather, the original disclosure needs to reasonably convey to one of ordinary skill in the art that the inventor had in his possession, as of the filing date of the

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<sup>3</sup> In re Smith, 481 F.2d 910, 914, 178 USPQ 620, 624 (CCPA 1973).

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application, the later added limitation.<sup>4</sup> In the present case, we are satisfied that the original specification reasonably conveys the concept that the restraining means is operatively interposed between the stabilizer and the tail pulley in such a way that when the oil skimmer is in use the tail pulley adopts a floating movement that is free of engagement, or contact, with the restraining means. The portion of appellant's specification cited by the examiner simply relates that the tail pulley is constrained by engagement with the restraining means either when the belt breaks or when the skimmer is transported.

In addition, we will not sustain the examiner's prior art rejections based on Abanaki. Accordingly, we reverse the examiner's rejection of claims 1-3, 5 and 6 under § 102/§ 103 over Abanaki, the rejection of claim 4 under § 103 over Abanaki, the rejection of claims 8-11 under § 103 over Abanaki in view of Spurr, the rejection of claims 7 and 18 under § 103 over Abanaki in view of Mecham and the rejection of claim 7 over Abanaki in view of Combrowski. The fatal flaw in all these rejections is that Abanaki does not teach or suggest a

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<sup>4</sup> Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555, 1563, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991).

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transportable oil skimmer comprising a restraining means that is so disposed between the stabilizer and the tail pulley as to allow for floating movement of the tail pulley when in use. Although it cannot be gainsaid that the examiner is correct in stating that there must be a clearance between the bore of the tail pulley and the shaft or bolt inserted therein "to permit rotation of the tail pulley" (page 6 of Answer), it is not reasonable to conclude that such a limited clearance between the tail pulley and the shaft would necessarily or inherently allow for the tail pulley to assume floating movement while in use. Indeed, the Hobson Declaration of December 19, 1994 evidences that the prior art oil skimmer disclosed by Abanaki does not comprise a tail pulley that freely floats when in use. Spurr, Combrowski and Mecham, the secondary references cited by the examiner, do not remedy this basic deficiency of Abanaki.

We will sustain the examiner's rejection of claim 16 over Combrowski. The method of claim 16 does not define the relationship between the restraining means, stabilizer and tail pulley discussed above. Claim 16 recites a conventional method of skimming oil from the surface of a body of water

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with, according to appellant, the distinction that a tail pulley is employed that has "L-shaped spokes including legs and arms." Here, we agree with the examiner that Combrowski fairly teaches a method of skimming oil with a tail pulley comprising vanes **35** that closely correspond to the claimed spokes. We agree with the examiner that the general shape of Combrowski's vanes fairly suggests L-shaped spokes having arms and legs that are oriented in the direction of the pulley rotation. Furthermore, Combrowski expressly teaches that "[t]he geometrical shape of said vanes **35** can be developed in different ways, the requirement of the user always being important in this connection" (column 4, lines 51-54). In our view, any distinction between the shape of Combrowski's vanes and shapes within the scope of claim 16 would have been an obvious matter of design choice for one of ordinary skill in the art. We note that appellant presents no argument that the shape of the claimed spokes offers a particular advantage or solves a specific problem not achieved by the vanes of Combrowski. In re Kuhle, 526 F.2d 553, 555, 188 USPQ 7, 9 (CCPA 1975). Also, we note that appellant bases



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no argument upon objective evidence of nonobviousness with respect to the rejection of claim 16.

In conclusion, based on the foregoing, the examiner's rejection of claims 1-11, 18 and 20 is reversed, whereas the examiner's

§ 103 rejection of 16 is affirmed. Accordingly, the examiner's decision rejecting the appealed claims is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

SHERMAN D. WINTERS	)	
Administrative Patent Judge	)	
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	)	
	)	
EDWARD C. KIMLIN	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
BRADLEY R. GARRIS	)	
Administrative Patent Judge	)	

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Watts, Hoffman, Fisher & Heinke Co.  
P.O. Box 99839  
Cleveland, OH 44199-0839

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